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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/037,782 | 01/02/2002 | Ronald A. Katz | 228/052 | 7708 |

35554 7590 06/22/2004

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EXAMINER

WOO, STELLA L

| ART UNIT | PAPER NUMBER |
|----------|--------------|
| 2643 | 13 |

DATE MAILED: 06/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/037,782

Applicant(s)

KATZ, RONALD A.

Examiner

Stella L. Woo

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 May 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 26-45 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 26-45 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 10.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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DETAILED ACTION

1. The indicated allowability of claims 26-45 in the final Office action mailed November 3, 2003 is withdrawn in view of the newly discovered reference to Canadian Patent No. 1,162,336 (hereinafter "DeBruyn"). Rejections based on the newly cited reference follow.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 26-42, 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over DeBruyn in view of Szlam et al. (US 4,797,911, hereinafter "Szlam").

DeBruyn discloses a method for controlling voice-data communications for use with a communication facility (telephone exchange 3) including remote terminals (telephone sets 1), the method comprising the steps of:

cuing select one of said remote terminals in accordance with a select format to prompt selective actuation (telephone reply apparatus 8 prompts a caller using a specific language format to enter a Lotto number; page 3, lines 24-26; page 4, line 23 – page 5, line 6);

selectively receiving said responsive signals (entered Lotto number is received and stored in memory 9; page 3, lines 26-28; page 5, lines 6-11);

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testing at least certain of the digital data signals to determine whether callers have exceeded a limit on use (converting and confirming apparatus 11 determines whether the phone number of the caller has already been recorded for the current Lotto game; page 5, lines 11-21; page 3, line 28 – page 4, line 5); and

confirming via a voice generator (data entered by the caller is stored in memory 9 and repeated in spoken form to the caller by converting and confirming apparatus 11; page 4, lines 5-8; page 5, lines 22-26).

DeBruyn differs from claims 26 and 31 in that it does not provide for the step of transferring calls to at least one live operation station. However, Szlam teaches the desirability of transferring a call to an operator terminal (col. 12, lines 9-66), in which both data entered by the caller (telephone number or account number; col. 13, lines 18-22) and data stored for the caller (customer account information previously stored in the mainframe 16; col. 12, lines 39-42) is displayed upon the screen of the operator terminal (col. 13, lines 22-29). It would have been obvious to an artisan of ordinary skill to incorporate such use of an operator terminal, as taught by Szlam, within the method of DeBruyn in order to provide human assistance as well as to collect more detailed information regarding the caller.

Regarding claims 27 and 32-33, Szlam teaches an ANI decoder 10a24 for receiving calling number identification data signals (col. 12, lines 29-39).

Regarding claims 28, 34-35, in DeBruyn, a caller's language format is determined based on the caller's telephone number (page 4, lines 23-26).

Regarding claims 29, 40, 45, Szlam provides for recording audio signals via a message recorder for later playback to an operator terminal (col. 17, lines 27-46).

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Regarding claims 30 and 41, the messages can be in analog or digital form (col. 17, lines 32-34).

Regarding claims 36-38, in DeBruyn, an individual caller, as identified by the calling telephone number, is permitted a certain number of stakes per week (page 3, line 28 – page 4, line 5; page 5, lines 11-20).

Regarding claim 39, it is well known in the gaming art to restrict the number of entries such that it would have been obvious to an artisan of ordinary skill to isolate a subset of callers by accepting a first set of callers for participation in the Lotto game of DeBruyn.

Regarding claim 42, in DeBruyn, data entered by the caller is stored in memory 9 and repeated in spoken form to the caller by converting and confirming apparatus 11; page 4, lines 5-8; page 5, lines 22-26).

4. Claims 43-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of DeBruyn and Szlam, as applied to claim 41 above, and further in view of Entenmann et al. (US 4,996,705, hereinafter “Entenmann”).

The combination of DeBruyn and Szlam differs from claim 43 in that it does not specify providing callers with a computer generated number. However, Entenmann discloses a lottery system in which a caller is provided with the option of receiving a computer generated lottery number as an alternative to entering a lottery number (col. 3, lines 8-14) such that it would have been obvious to an artisan of ordinary skill to incorporate the option of providing a computer generated lottery number, as taught by Entenmann, within the combination of DeBruyn and Szlam in order to enhance the lottery game experience by providing more options for the caller.

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Regarding claim 44, in Entenmann, a caller can provide a credit card number as a billing option (col. 2, lines 63-65).

Double Patenting

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 26-29 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 35-39 of U.S. Patent No. 6,570,967.

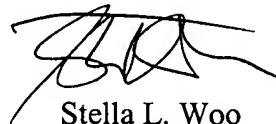
Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 26-29 of the present invention is broader than claims 35-39 of the patent, *In re Van Ornum and Stang*, 214 USPQ 761. For example, claim 26 of the present invention is the same as claim 35 of the patent except it does not recite "processing the other data for the individual caller utilizing multiple comparative operations." Therefore, claim 26 is broader than patented claim 35.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stella L. Woo whose telephone number is (703) 305-4395. The examiner can normally be reached on Monday-Tuesday, Thursday-Friday.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Curtis Kuntz can be reached on (703) 305-4708. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Stella L. Woo
Primary Examiner
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